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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,750	02/11/2004	John Hancock	P-3563	3612
37572	7590	01/09/2006	EXAMINER	
PROMEX TECHNOLOGIES, LLC 3049 HUDSON STREET FRANKLIN, IN 46131			APANIUS, MICHAEL	
			ART UNIT	PAPER NUMBER
			3736	
DATE MAILED: 01/09/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/776,750

Applicant(s)

HANCOCK, JOHN

Examiner

Michael Apanius

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-22 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 05072004&12272005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "71" has been used to designate both the free end of cocking lever "70" in figure 1 and the pivot point "71" in figure 2. The drawings are further objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: forward slider "61" (paragraph 57, lines 3-4) and internal spring "39" (paragraph 65, lines 5 and 10). Furthermore, both angles in figure 2 should be labeled -- α --. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "102" in figure 26. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application.
3. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37

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CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The abstract of the disclosure is objected to because it contains more than 150 words. Correction is required. See MPEP § 608.01(b).
5. The disclosure is objected to because of the following informalities:
 - a. At paragraph 29, line 1 and paragraph 30, line 1, "top" should be --side--.
 - b. At paragraph 36, line 1, "the device 20" should be either --the device 10-- or --the housing 20--.
 - c. At paragraph 52, line 12, "forward carrier 92" should be -- forward carrier 62--.
 - d. At paragraph 58, lines 6-9, the engaged and released positions appear to be inconsistent and reversed to what is discussed in paragraphs 60 and 69.
 - e. At paragraph 63, line 2, the first recitation of "the" should be deleted.

Appropriate correction is required.

Claim Objections

6. Claims 1-10 and 12-22 are objected to because of the following informalities:
 - a. At claim 1, line 22, --first-- should be inserted before "cocked position".

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- b. At claim 1, lines 35 and 72, --second-- should be inserted before "cocked position".
- c. At claim 1, line 68, --second-- should be inserted before "resting position".
- d. At claim 1, lines 66 and 69, --of said cocking slider-- should be inserted after "said forward end".
- e. At claim 1, line 70, --of said cocking slider-- should be inserted after "said rearward end".
- f. At claim 3, line 4, --of said housing-- should be inserted after "said rearward end".
- g. At claim 12, line 3, the semicolon should be a colon.
- h. At claim 13, line 2, --the-- should be inserted before "cocking slider".
- i. At claim 17, line 5, --second elongated-- should be inserted before "beam".
- j. At claim 21, line 21 and claim 22, line 7, the semicolon should be a colon.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-10, 16, 17 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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9. At claim 1, line 44, the relation of "an opposite end" to the surrounding claim language is indefinite. For example, it is not clear if it is structurally part of the forward cocking beam or if it is related to the pivotal attachment to the forward end of the housing.

10. At claim 1, line 69, "said forward slider" lacks antecedent basis. Note that a "forward slider" has not been previously recited in the claim.

11. At claim 9, lines 5-6, "said safety knob" lacks antecedent basis. Note that claims 1 and 9 do not previously recite a "safety knob".

12. At claim 16, line 3, it is not clear to what the "second elongated beam" is connected.

13. At claim 22, line 9, "said elongated bar" lacks antecedent basis. Note that claims 21 and 22 do not previously recite an "elongated bar".

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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15. Claims 11-14 and 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Schramm et al. (US 5,476,101).

16. In regards to claim 11, Schramm et al. disclose an automatic tissue sampling apparatus for use with a biopsy needle set (22 in figures 5-7) having an inner needle and an outer cannula, comprising: a housing (24) having a forward end defining an opening (in the front of figure 3) for passage of the inner needle and outer cannula, said housing defining an interior cavity; a first carrier (46) slidably disposed within said interior cavity of said housing and having a portion configured to support one of the inner needle and the outer cannula; a second carrier (47) slidably disposed within said interior cavity and having a portion configured to support the other of the inner needle and the outer cannula; a first driving mechanism (55 in figure 4, 58 in figure 8) disposed within said interior cavity in operable engagement with said first carrier, said first driving mechanism having a cocked position in which said mechanism stores potential energy and a firing position in which said mechanism releases the potential energy to drive said first carrier toward said forward end of said housing; a second driving mechanism (56 in figure 4, 70 in figure 6) disposed within said interior cavity in operable engagement with said second carrier, said second driving mechanism having a cocked position in which said mechanism stores potential energy and a firing position in which said mechanism releases the potential energy to drive said second carrier toward said forward end of said housing; and a cocking mechanism (see figures 5-9) operable to sequentially move said first driving mechanism to its cocked position and said second driving mechanism to its cocked position, said cocking mechanism including a manually operated cocking

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lever (28) positioned outside said housing for single-handed manipulation while holding said housing. Note that the single-handed manipulation includes holding and positioning the device with a single hand.

17. In regards to claim 12, said cocking lever is pivotally supported (around pin 32) on said housing; and said cocking mechanism includes: a cocking slider (40) having an engagement portion (64, 65), said cocking slider slidably disposed within said housing so that when said cocking slider slides in a rearward direction away from said forward end of said housing said engagement portion applies a force against at least one of said first and second carriers to move the carrier to its cocked position; and a force transmission mechanism (42) engaged between said cocking lever and said cocking slider and configured to translate pivoting movement of said cocking lever to sliding movement of said cocking slider in said rearward direction against said at least one of said first and second carriers.

18. In regards to claim 13, the cocking slider is an elongated bar; and said engagement portion includes a forward engagement member (64) defined at a forward end of said bar arranged to engage said first carrier and a rearward engagement member (65) arranged to engage said second carrier.

19. In regards to claim 14, said force transmission mechanism includes a first elongated beam (42) slidably supported (around pin 43) at one end by said cocking lever and pivotally connected (around pin 44) at an opposite end to said elongated bar. Note that since the elongated beam is supported around pin 43, it is slidably supported because it can slide around that pin.

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20. In regards to claim 18, said forward engagement member defines a hook for engaging said first carrier to pull said first carrier as said cocking slider slides rearward.

21. In regards to claim 19 and 20, said rearward engagement member defines a notch for engaging said second carrier to push said second carrier as said cocking slider slides rearward.

22. In regards to claim 21, the driving mechanisms include compressible springs (55, 56) and the cocking mechanism is operable to compress the springs. Although Schramm et al. may not expressly disclose that the force transmission mechanism is configured so that the force required to manually depress the cocking lever to compress the springs does not increase as the springs are compressed, it is deemed that the configuration of Schramm et al. is capable of meeting this limitation due to the pivotal arrangement of the cocking lever and the force transmission mechanism.

23. Claim 21 is rejected under 35 U.S.C. 102(e) as being anticipated by Weilandt et al. (US 2003/0163152).

24. Weilandt et al. disclose an automatic tissue sampling apparatus for use with a biopsy needle set having an inner needle (canula; paragraph 49) and an outer cannula (201), comprising: a housing (500) having a forward end defining an opening (in the front of figure 1) for passage of the inner needle and outer cannula, said housing defining an interior cavity; a first carrier (543) slidably disposed within said interior cavity of said housing and having a portion configured to support one of the inner needle and the outer cannula; a second carrier (544) slidably disposed within said interior cavity

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and having a portion configured to support the other of the inner needle and the outer cannula; a first driving mechanism (see figures 4-9) disposed within said interior cavity in operable engagement with said first carrier, said first driving mechanism including a first spring (one spring of 601) compressible to a cocked position to store potential energy and releasable from said cocked position to release the potential energy to drive said first carrier toward said forward end of said housing; a second driving mechanism (see figure 4-9) disposed within said interior cavity in operable engagement with said second carrier, said second driving mechanism including a second spring (another spring of 601) compressible to a cocked position to store potential energy and releasable from said cocked position to release the potential energy to drive said second carrier toward said forward end of said housing; and a cocking mechanism operable to compress said first spring, said cocking mechanism including: a cocking lever (520) positioned outside said housing and pivotally mounted to said housing to be manually depressed against the housing; and a force transmission mechanism (530) operably coupled between said cocking lever and said first carrier and configured so that the force required to manually depress said cocking lever to compress said first spring does not increase as said first spring is compressed.

Allowable Subject Matter

25. Claims 1-10 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

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26. Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and overcoming the objections to the base and intervening claims set forth in this Office action.

27. Claims 16, 17 and 22 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

28. The following is a statement of reasons for the indication of allowable subject matter: no prior art of record teaches or fairly suggests an automatic tissue sampling apparatus having a cocking assembly that includes a forward cocking beam, a rearward cocking beam and a beam bearing or an automatic tissue sampling apparatus having a cocking assembly that includes an elongated beam attached closer to the forward end of an elongated bar than to the rearward end of the bar.

Conclusion

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,752,923 discloses a biopsy instrument with handle and needle set. US 6,126,617 discloses an impact-damped biopsy instrument. US 2002/0120212 discloses methods and devices for automated biopsy and collection of soft tissue.

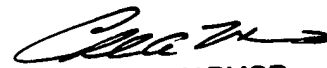
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30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Apanius whose telephone number is (571) 272-5537. The examiner can normally be reached on Mon-Fri 8:30am-5pm.

31. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

32. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA


CHARLES MARMOR
PRIMARY EXAMINER